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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91190794
Party	Defendant Envirodine Studios Inc.
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	02/04/2010
Attachments	Motion to Amend Answer to Notice of Opposition and Counterclaim with Exhibits.pdf (22 pages)(1484297 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

UNILEVER SUPPLY CHAIN, INC.,

Opposer/Respondent,

v.

ENVIRODINE STUDIOS, INC.,

Applicant/Petitioner.

Opposition No.

91190794

**APPLICANT/PETITIONER’S MOTION TO AMEND ANSWER
TO NOTICE OF OPPOSITION AND COUNTERCLAIM**

Applicant/Petitioner, Envirodine Studios, Inc. (“Envirodine”), by its undersigned counsel, hereby moves the Board pursuant to Federal Rule of Civil Procedure 15(a) for leave to amend the Answer to Notice of Opposition to assert a counterclaim for cancellation of Opposer/Respondent, Unilever Supply Chain, Inc.’s. (“Unilever”), pleaded registrations. Envirodine’s Proposed Amended Answer to Notice of Opposition is attached hereto as Exhibit 1.

PRELIMINARY STATEMENT

Envirodine seeks to amend its Answer to Notice of Opposition to assert a counterclaim for cancellation of Unilever’s pleaded registrations, on the grounds that Unilever has abandoned two of its pleaded registered marks, namely, Registration Nos. 1,126,015 (SUPERSICLE) and 2,314,773 (SUPERSICLE and Design).

Envirodine should be permitted to amend its Answer to Notice of Opposition to counterclaim for cancellation of the SUPERSICLE marks because Unilever has abandoned its

marks. Envirodine's amendment is meritorious, is amply supported by evidence, and Unilever will not be prejudiced by the amendment because discovery in this matter is still ongoing.

FACTUAL BACKGROUND

Envirodine is seeking to register the mark SCENTSICLES as depicted in Application No. 77/546,243 based on use under Section 1(a) of the Lanham Act (15 U.S.C. § 1051(a)), for "Christmas tree decorations; Christmas tree ornaments; [and] Christmas tree ornaments and decorations" in Class 28 (hereinafter, the "SCENTSICLES Application"). On December 30, 2008, the SCENTSICLES Application was published for opposition.

On June 26, 2009, Unilever filed a Notice of Opposition to the SCENTSICLES Application on the ground that Envirodine's mark is likely to cause confusion with Unilever's family of marks that feature the 'SICLE' suffix. Unilever pleaded nine (9) registered marks, including the following (hereinafter, the "SUPERSICLE marks"):

MARK	REG. NO.	REG. DATE	GOODS
SUPERSICLE	1,126,015	October 16, 1979	Frozen confections and concentrates for making the same
SUPERSICLE	2,314,773	February 1, 2000	Frozen confections

On August 3, 2009, Envirodine filed its Answer. After Envirodine filed its Answer, it became aware that Unilever was no longer using its SUPERSICLE marks in any manner, and specifically with regard to the registered goods. Envirodine investigated Unilever's corporate websites (at <http://www.unilever.com> and <http://www.unileverusa.com>) and found no evidence of use of the SUPERSICLE marks. As evidence of the same, Envirodine submits as Exhibit 2 a screenshot showing a listing of Unilever's food brands (*available at*

<http://www.unileverusa.com/brands/foodbrands/>). As demonstrated in Exhibit 2, SUPERSICLE is not identified as a separate food brand. Moreover, a search for the term “SUPERSICLE” on all of Unilever’s corporate websites found no results. (Exhibit 3).

Envirodine also investigated Unilever’s POPSICLE website (*at* <http://www.popsicle.com>) and found no evidence of use of the SUPERSICLE marks. As evidence of the same, Envirodine submits as Exhibit 4 screenshots from the POPSICLE website showing the various food products sold under the POPSICLE, FUDGSICLE, and CREAMSICLE marks. As demonstrated in Exhibit 4, SUPERSICLE frozen confections are not shown as products sold by Unilever.

After filing its Answer, Envirodine also became aware that Unilever’s deadlines to file Section 9 renewals for Registration Nos. 1,126,015 and 2,314,773 had lapsed. The deadline to file the Section 9 renewal for Registration No. 1,126,015 lapsed on October 16, 2009, and the deadline to file the Section 9 renewal for Registration No. 2,314,773 lapsed on February 1, 2010, without Unilever filing a renewal or otherwise evidencing any proof of use of the SUPERSICLE marks.

Accordingly, Envirodine now seeks to amend its Answer to add a counterclaim to cancel Registration Nos. 1,126,015 and 2,314,773 for the SUPERSICLE marks on the ground that Unilever has abandoned its use of the marks and has no current intent to resume use of the SUPERSICLE marks.

ARGUMENT

Federal Rule of Civil Procedure 15(a) requires that leave to grant an amendment to a pleading be freely given when justice requires. Fed. R. Civ. P. 15(a). The Board liberally grants

leave to amend pleadings at any stage of the proceedings when justice requires, unless entry of the proposed amendment would violate settled law or would be prejudicial to the adverse party. TBMP § 507.02. Envirodine’s motion to amend its Answer to Notice of Opposition and add a counterclaim for cancellation of Unilever’s pleaded registrations based on abandonment should be granted because the amendment is well-pled, timely, and will not prejudice Unilever.

I. ENVIRODINE’S AMENDMENT IS WELL-PLED

Envirodine’s amendment is well-pled because the Proposed Amended Answer to Notice of Opposition and Counterclaim sets forth, in detail, that Unilever has abandoned its SUPERSICLE marks due to non-use with no intention to resume use of the marks. A mark is deemed “abandoned” when “its use has been discontinued with intent not to resume such use.” 15 U.S.C. § 1127. Moreover, nonuse for three (3) consecutive years is *prima facie* evidence of abandonment. Id. A petition to cancel a registration of a mark may be filed at any time if the registered mark has been abandoned. 15 U.S.C. § 1064(3).

Envirodine alleges that Unilever has abandoned the SUPERSICLE marks due to non-use with no intention to resume use of the marks. (Proposed Amended Answer to Notice of Opposition and Counterclaim at ¶¶ 6 and 11). Envirodine also alleges that Unilever has not used the SUPERSICLE marks for at least the past 3 consecutive years prior to the filing of the Proposed Amended Answer. (Id. at ¶¶ 7 and 12). Cancellation is proper because Unilever is not using the SUPERSICLE marks in commerce, as evidenced by its non-use of the marks on any of its corporate websites or its POPSICLE website. (Exhibits 2 and 3). Unilever’s failure to file the required Section 9 renewals for the SUPERSICLE marks is further evidence of Unilever’s non-use of the SUPERSICLE marks, with no intent to resume use.

In sum, Envirodine's proposed amendment fully satisfies the pleading requirements to establish that Unilever has abandoned the SUPERSICLE marks and, therefore, Registration Nos. 1,126,015 and 2,314,773 should be cancelled.

II. ENVIRODINE'S AMENDMENT IS TIMELY AND WILL NOT PREJUDICE OPPOSER

Envirodine's proposed amendment is timely and will not prejudice Unilever because Envirodine became aware of the abandonment after Unilever failed to file its Section 9 renewal of Registration No. 1,126,015 in October 2009, and Envirodine was able to complete its investigation of Unilever's non-use of the SUPERSICLE marks. Envirodine's amendment was made promptly after the investigation failed to reveal any use of the SUPERSICLE marks in connection with the claimed goods and after Unilever failed to file its Section 9 renewal of Registration No. 2,314,773 on February 1, 2010.

Unilever will not be prejudiced by the proposed amendment because discovery in this matter is still ongoing and does not close until March 3, 2010. Unilever has ample time to formulate its strategy and take discovery in response to the amended Answer. The Board has routinely held that a party suffers no prejudice when a motion to amend a pleading is filed prior to the close of discovery. *See e.g., Commodore Electronics, Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (TTAB 1993); *Flatley v. Trump*, 11 U.S.P.Q.2d 1284 (TTAB 1989). Moreover, there is no basis for Unilever to contend that it will suffer prejudice as a result of this amendment since all of the contended facts and information are within Unilever's control.

CONCLUSION

For all the foregoing reasons, Envirodine respectfully requests that the Board grant its Motion to Amend. Additionally, Envirodine requests that the Board suspend the proceeding

pending the disposition of Envirodine's Motion to Amend. Envirodine submits herewith the fee of \$600.00, representing the fee for a petition to cancel Registration Nos. 1,126,015 and 2,314,773 (each a single-class registration), as required by 37 C.F.R. §§ 2.111(c)(1) and 2.6(a)(16).

Respectfully submitted,

This 4th day of February, 2010

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ATTORNEYS FOR APPLICANT/PETITIONER

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

UNILEVER SUPPLY CHAIN, INC.,

Opposer/Respondent,

v.

ENVIRODINE STUDIOS, INC.,

Applicant/Petitioner.

Opposition No.

91190794

CERTIFICATE OF SERVICE

I hereby certify that a copy of **APPLICANT/PETITIONER'S MOTION TO AMEND ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM** has been served upon Opposer, by causing a true and correct copy thereof to be delivered in the manner indicated below and properly addressed to the following counsel of record:

<input type="checkbox"/>	By Hand	Kristin H. Altoff
<input type="checkbox"/>	By Facsimile	Morgan, Lewis & Bockius LLP
<input checked="" type="checkbox"/>	By US Postal Service (1 st Class)	1111 Pennsylvania Ave., NW
<input type="checkbox"/>	By Overnight Delivery	Washington, DC 20004
<input checked="" type="checkbox"/>	By Email	trademarks@morganlewis.com ;
		kaltoff@morganlewis.com ;
		apolott@morganlewis.com
		202.739.5093

This 4th day of February, 2010

/Cecilia M. Andrews/
Cecilia M. Andrews

EXHIBIT 1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

UNILEVER SUPPLY CHAIN, INC.,

Opposer/Respondent,

v.

ENVIRODINE STUDIOS, INC.,

Applicant/Petitioner.

Opposition No.

91190794

**APPLICANT/PETITIONER'S AMENDED ANSWER
TO NOTICE OF OPPOSITION AND COUNTERCLAIM**

Applicant/Petitioner, Envirodine Studios, Inc. ("Applicant"), by its undersigned counsel, hereby answers the Notice of Opposition filed by Opposer/Respondent, Unilever Supply Chain, Inc. ("Opposer") as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the allegations set forth in paragraph 1 of the Notice of Opposition, which therefore stand denied.
2. Applicant is without knowledge or information sufficient to form a belief as to the allegations set forth in paragraph 2 of the Notice of Opposition, which therefore stand denied.
3. Applicant is without knowledge or information sufficient to form a belief as to the allegations set forth in paragraph 3 of the Notice of Opposition, which therefore stand denied.
4. Applicant is without knowledge or information sufficient to form a belief as to the allegations set forth in paragraph 4 of the Notice of Opposition, which therefore stand denied.
5. Applicant is without knowledge or information sufficient to form a belief as to the allegations set forth in paragraph 5 of the Notice of Opposition, which therefore stand denied.

6. Applicant is without knowledge or information sufficient to form a belief as to the allegations set forth in paragraph 6 of the Notice of Opposition, which therefore stand denied.

7. Applicant denies the allegations set forth in paragraph 7 of the Notice of Opposition.

8. Applicant is without knowledge or information sufficient to form a belief as to the allegations set forth in paragraph 8 of the Notice of Opposition, which therefore stand denied.

9. Applicant admits the allegations set forth in paragraph 9 of the Notice of Opposition.

10. Applicant admits the allegations set forth in paragraph 10 of the Notice of Opposition.

11. Applicant admits the allegations set forth in paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations set forth in paragraph 12 of the Notice of Opposition.

13. Applicant denies the allegations set forth in paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations set forth in paragraph 14 of the Notice of Opposition.

15. Applicant denies the allegations set forth in paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations set forth in paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegations set forth in paragraph 17 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

18. Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.

19. Opposer's claims are barred by the doctrine of laches.

WHEREFORE, Applicant respectfully requests that Opposition No. 91190794 be dismissed with prejudice and that a registration should issue for Applicant's mark SCENTSICLES.

COUNTERCLAIM

Applicant, pursuant to 15 U.S.C. §1064(3), believes it will be damaged by the continued registration of Registration Nos. 1,126,015 (SUPERSICLE) and 2,314,773 (SUPERSICLE and Design), respectively, and hereby counterclaims for cancellation of Opposer's federal registrations as follows:

1. Applicant is the owner of a pending application for the mark SCENTSICLES (Serial No. 77/546243) for "Christmas tree decorations; Christmas tree ornaments; Christmas tree ornaments and decorations" in Class 28.

2. Opposer is the listed owner of Registration No. 1,126,015 for the mark SUPERSICLE in connection with the goods "frozen confections and concentrates for making the same" in Class 30 ("015 Registration").

3. Opposer has pled the '015 Registration in its Notice of Opposition for the present proceeding.

4. Pursuant to 15 U.S.C. § 1059, the deadline for Opposer to file its Section 9 declaration for the '015 Registration was October 16, 2009.

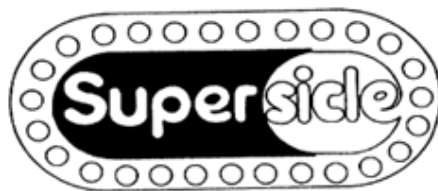
5. To date, Opposer has not filed its Section 9 declaration for the '015 Registration.

6. Upon information and belief, Opposer does not presently use the mark of the '015 Registration in connection with the goods listed in the registration and has no intention to use the mark of the '015 Registration therewith.

7. Upon information and belief, Opposer has not used the mark of the '015 Registration in connection with the goods listed in the registration for at least the past 3 consecutive years prior to the filing of this Answer, and has no intention to use the mark of the '015 Registration therewith.

8. Accordingly, the '015 Registration should be cancelled.

9. Opposer is the listed owner of Registration No. 2,314,773 for the mark SUPERSICLE and Design in connection with the goods “frozen confections” in Class 30 (the “’773 Registration”). The mark of the '773 Registration is depicted below:



10. Opposer has pled the '773 Registration in its Notice of Opposition for the present proceeding.

11. Upon information and belief, Opposer does not presently use the mark of the ‘773 Registration in connection with the goods listed in the registration and has no intention to use the mark of the ‘773 Registration therewith.

12. Upon information and belief, Opposer has not used the mark of the ‘773 Registration in connection with the goods listed in the registration for at least the past 3 consecutive years prior to the filing of this Answer, and has no intention to use the mark of the ‘015 Registration therewith.

13. Accordingly, the ‘773 Registration should be cancelled.

WHEREFORE, Applicant respectfully requests that Registration Nos. 1,126,015 and 2,314,773 be cancelled pursuant to 15 U.S.C. §1064(3), on the basis of Opposer’s loss of rights in the marks due to abandonment.

Respectfully submitted,

This 4th day of February, 2010

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ATTORNEYS FOR APPLICANT/PETITIONER

EXHIBIT 2



Our brands

Food brands

- Ben & Jerry's®
- Bertolli®
- Breyer's®
- Good Humor®
- Hellman's®
- I Can't Believe It's Not Butter®
- Klondike®
- Knorr®
- Knorr® (Lipton®) Sides
- Lipton®
- Popsicle®
- Promise®
- Ragù®
- Shedd's Spread Country Crock®
- Skippy®
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> Bertolli®

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Trusted for over 140 years.



> Breyers®

Trusted for over 140 years.



> Good Humor®

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> Hellmann's®

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> I Can't Believe It's Not Butter!®

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Trusted for 30 years.



> Klondike®

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> Knorr®

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> Knorr® (Lipton®) sides

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Trusted for 26 years.



> Lipton®

Drink Better Everyday. Live Better Everyday.

Trusted For 105 Years



> Popsicle®

The cool taste of Popsicle.

Trusted for 85 years.



> Promise®

Taking your health to heart.

Trusted for 33 years.



> Ragù®

Feed our Kids Well™

Trusted for over 70 years.



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Trusted for over

20 years.



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years.

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